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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,381	01/23/2006	Julen Burgou Arteche	R.306459	5559
2119	7590	05/11/2010		
RONALD E. GREIGG GREIGG & GREIGG P.L.L.C. 1423 POWHATAN STREET, UNIT ONE ALEXANDRIA, VA 22314			EXAMINER GONZALEZ, MADELINE	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 05/11/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,381

Applicant(s)

ARTECHE ET AL.

Examiner

MADELINE GONZALEZ

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-19, 25-28 and 30-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19, 25-28 and 30-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In response to applicant's amendment dated March 12, 2010

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-19, 25-28, 31-35, 38 and 39 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins et al. (U.S. 5,620,599) [hereinafter Hopkins].

With respect to **claims 15, 17, 31 and 32**, Hopkins discloses a filter assembly 100, as shown in Fig. 1, having:

- an elongated filter housing 200 having a longitudinal axis;
- at least one substantially elongated filter element 302 contained in the housing 200, the at least one filter element 302 having a clean side and a dirty side and are situated essentially parallel to each other, the clean side being disposed between a first elongated surface of the filter element 302 and a wall of the housing 200, and the dirty side being disposed between a second elongated surface of the filter element 302 and a wall of the housing 200, which second elongated surface opposes the first elongated surface;

- an inlet 202, provided on an end of the housing 200 and an outlet 204 provided on an end of the housing 200;
- at least one wall 400 encapsulating the clean side of the filter element 302, the at least one encapsulating wall 400 being disposed between the clean side of the filter element 302 and the wall of the filter housing 200;
- wherein the filter element 302 and the at least one encapsulating wall together constitute a filter insert which is inserted into the housing 200, as shown in Fig. 3; and
- a gap in the region of the inlet 202 extending in the longitudinal direction of the filter housing 200 between the at least one wall 400 encapsulating the clean side of the filter element 302 and the wall of the filter housing 200;
- wherein the at least one wall 400 encapsulating the clean side of the filter element 200 has grooves 411 in the side of the wall oriented toward the wall of the filter housing 200 forming part of the gap, as shown in Fig. 3;
- wherein the filter housing 200 includes a housing part and a cover 208 that closes the housing part, as shown in Fig. 3.

Hopkins **lacks** the specific shape of the housing, i.e., flat and having at least first and second longitudinally extending side walls, and opposing ends extending vertically to the longitudinal axis; the specific shape of the filter element, i.e., being embodied overall as planar or flat in shape; the specific shape of the filter material, i.e., folded essentially into the shape of a block; and the specific shape of the housing part, i.e., blocked-shaped housing part.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the filter housing and filter element disclosed by Hopkins with the shapes claimed by applicant, since the courts have held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant (see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)) and since Hopkins in suggesting that the housing may be configured in a variety of ways (see col. 3, lines 17-18) and the filter element may have any suitable configuration (see col. 3, line 67 and col. 4, line 1).

With respect to **claim 16**, Hopkins discloses wherein the filter element 302 includes a folded filter material, as shown in Fig. 2.

With respect to **claims 18 and 19**, Hopkins discloses wherein the filter insert includes an encapsulated clean side that is connected to the outlet 204, as shown in Fig. 4.

With respect to **claim 25**, Hopkins discloses wherein the inlet 202 and the outlet 204 are provided on the same end of the filter housing 200, as shown in Fig. 3.

With respect to **claim 26**, Hopkins discloses wherein the inlet 202 and the outlet 204 are provided on opposite ends of the filter housing 200 (see col. 3, lines 41-42).

With respect to **claim 27**, Hopkins discloses a flow entry that at least reduces turbulence in the region of the side where the flow strikes the filter element 302, as shown in Fig. 3.

With respect to **claim 28**, Hopkins discloses a flow baffle 304 provided in the inlet 202, as shown in Fig. 3.

With respect to **claim 33**, Hopkins discloses wherein the housing part and the cover 208 are connected to each other, as shown in Fig. 3. Hopkins **lacks** the connection being nondetachable. However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the connection between the housing part and the cover disclosed by Hopkins nondetachable, as claimed by applicant, in order to facilitate its handling, since the courts have held that the use of a one piece construction instead of the structure disclosed in the prior art would be merely a matter of obvious engineering choice. (*See MPEP 2144.04 [R-1] (V) [In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)]*).

With respect to **claim 34**, Hopkins discloses a distribution stabilizer 304 on the inlet side, as shown in Fig. 3.

With respect to **claim 35**, Hopkins discloses wherein the grooves 411 in the encapsulating wall 400 include a plurality of parallel longitudinal grooves and parallel transverse grooves extending at approximately right angles to one another, as shown in Fig. 2.

With respect to **claim 38**, Hopkins discloses wherein the clean side of the filter element 302 is between the first elongated surface of the filter element 302 and the at least one encapsulating wall 400, as shown in Fig. 3.

With respect to **claim 39**, Hopkins discloses wherein the clean side of the filter element 302 is connected via a duct segment 500 to the outlet 204, as shown in Fig. 4.

Claim 30 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins (U.S. 5,620,599) in view of Domnick (U.S. 4,105,561).

With respect to **claim 30**, Hopkins teaches an end cap 304 that has been considered a flow baffle, provided in the inlet 202, as shown in Fig. 3. Hopkins **lacks** wherein the flow baffle is inclined upward in relation to the flow direction.

Domnick teaches a filter housing 1, as shown in Fig. 1, having a cartridge including an upper end cap 7, said end cap 7 is inclined upward in relation to the flow direction. It would have been obvious to provide the end cap (baffle) disclosed by Hopkins inclined upward in relation to the flow direction as taught by Domnick in order

to allow the passage of fluid and since such inclination is considered to be a change in shape, and the courts have held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant (see *In re Dailey*, 357 F.2d 669,149 USPQ 47 (CCPA 1966))

Claim 36 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins (U.S. 5,620,599) in view of Janik et al. (U.S. 6,364,121) [hereinafter Janik].

With respect to **claim 36**, Hopkins **lacks** wherein the second side wall of the filter housing slopes downward toward a water outlet and constitutes a sump for water separated out on the dirty side of the filter element.

Janik teaches a filter assembly 10, as shown in Fig. 1, having a housing 60 having a wall sloping downward toward a water outlet and constitutes a sump 64 for water separated out on the dirty side of the filter element (see col. 3, lines 15-19). It would have been obvious to provide the filter housing disclosed by Hopkins with a wall sloping downward to form a sump and a water outlet as taught by Janik in order to collect any water that coalesces from the fuel, if the filter is used to filter fuel or oil (see col. 3, lines 15-19).

Claim 37 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins (U.S. 5,620,599) in view of Hawkins et al. (U.S. 6,361,684) [hereinafter Hawkins].

With respect to **claim 37**, Hopkins **lacks** wherein electrical connections for a heating unit, a temperature sensor and a water level sensor are provided on an end of the filter housing.

Hawkins teaches a filter assembly 20, as shown in Fig. 1, having a housing 21 having electrical connections for a heating unit 30, a temperature sensor 33 and a water level sensor 31, as shown in Fig. 3 in order to monitor such conditions in the filter (see col. 3, lines 31-44). It would have been obvious to provide the filter housing disclosed by Hopkins with the electrical connections disclosed by Hawkins in order to monitor the conditions of the fuel in the filter (see col. 3, lines 31-44).

Claim 40 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins (U.S. 5,620,599) in view of Coates et al. (U.S. 5,707,518) [hereinafter Coates].

With respect to **claim 40**, Hopkins **lacks** wherein the filter element is inserted inside the filter housing via guide rails provided on the side walls.

Coates teaches a filter assembly 22, as shown in Fig. 9, having a filter element 42 inserted inside a filter housing 40 via ribs 86 (guide rails). The ribs 86 support and radially align or orient the filter element 42 inside the housing 40 (see col. 5, lines 22-28). It would have been obvious to provide the housing disclosed by Hopkins with guide

rails as taught by Coated in order to support and radially align or orient the filter element inside the housing (see col. 5, lines 22-28).

Response to Arguments

Applicant's arguments with respect to claims 15-19, 25-28 and 30-40 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADELINE GONZALEZ whose telephone number is (571)272-5502. The examiner can normally be reached on M, W, Th, F- 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Krishnan S Menon/
Primary Examiner, Art Unit 1797

Madeline Gonzalez
Patent Examiner
May 7, 2010